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| 09/981,230 | 10/17/2001 | Steven B. McGowan | INTL-0625-US (P11956) | 5567 |

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Timothy N. Trop
TROP, PRUNER & HU, P.C.
STE 100
8554 KATY FWY
HOUSTON, TX 77024-1805

EXAMINER

EISEN, ALEXANDER

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,230

Applicant(s)

MCGOWAN, STEVEN B.

Examiner

Alexander Eisen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-23 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. **Claims 9 and 10** are objected to because of the following: claim 9 recites “said beam splitter arranged to reflect light from said display and said image sensor”. It should be noted that the sensor does not emit light and therefore there is no light to be reflected. As can be seen from FIG. 1 the beam splitter 18 reflects light from a scene 5 and directs it to the image sensor 20. In FIG. 2 the beam splitter 18 reflects light from the display 16 and directs it into the eye of the observer. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 14 and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Bell et al., (“Bell”), WO 96/27864 (this reference is provided with applicant’s IDS submission).

With respect to **claim 1** Bell discloses a device having a video camera (23), which can be a standard VHS video camera, which is inherently has an optic element to facilitate viewing, and an image sensor to capture frames (page 9, lines 27-32); a

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storage (18a) to store a sequence of frames (files; FIGS. 4A-B; pages 15-16)) of predetermined duration; a display (22) coupled to the storage to display the sequence of frames; a controller (processor 14) to automatically store sequence of frames and automatically overwrite an earlier sequence of frames.

As to **claim 14** Bell also discloses a method comprising recording a sequence of frames of predetermined duration; overwriting the recorded sequence with a following sequence of frames at substantially the same durations; and in response to a user selection to view the recorded sequence of frames (see page 24, line 7 – page 25, line 32).

As to **claim 19** Bell further teaches a computer system (10 in FIG. 4A) for implementing recording/replaying device comprising a medium (event capturing system with software memory 16) that enables a processor (14) based system to record a sequence of frames; to overwrite a sequence of frames with the subsequent sequence of frames and, in response to user selection enabling the user to view a recorded sequence of frames (see page 30, line 20 – page 31, line 27).

4. **Claims 1-7 and 12-23** are rejected under 35 U.S.C. 102(e) as being anticipated by Sisselman, US 2003/0007079 A1.

With respect to **claim 1**, Sisselman discloses a personal hand-held device (FIG. 5) comprising an optics element (lens 310) to facilitate viewing; an image sensor to capture frames (as part of image signal processor 320, see paragraph [0029]); a storage (RAM 370) to store sequence of frames of predetermined duration (see paragraph [0032]), whereas the storage is coupled to said sensor; a display (380) coupled to said storage to display the sequence of frames; and a controller (microprocessor 350) to automatically

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store successive sequence of frames of predetermined duration including an earlier and later sequences, said controller storing the later sequence of frames in the storage and automatically overwriting an earlier sequence (see FIGS. 6 and steps 620-640 in flow-chart diagram in FIG.8; also paragraphs [0033 – 0036]).

In regard to **claim 2**, Sisselman further teaches that the device controller loops back to a first sequence and overwrites the first sequence of frames with a second sequence of frames (see paragraph [0033] and FIG. 6).

As to **claims 3 and 4**, Sisselman also teaches that the storage has the capacity to store an integral number of sequences of frames of predetermined duration, (one in an exemplary embodiment consisting of twenty memory segments with 3 second duration each; see paragraph [0032]).

With regard to **claims 5 - 7**, the device of Sisselman is a camera with a magnifying (zoom) feature, and as such is effectively a camera, telescope or microscope when the functions it is capable of performing are taken into consideration.

As to **claim 12**, the only viewing means that the device of Sisselman has is the display (120), which is built-in into housing (110) (see FIGS. 1-4; paragraph [0025]).

As to **claim 13**, the controller enables a user to select when to display a sequence of frames of predetermined duration (see relevant function of replay button 190 in paragraphs [0028] and [0031]).

With respect to **claim 14**, Sisselman teaches the device corresponding method, wherein a sequence of frames of predetermined duration is recorded and consequently is overwritten by a following sequence of frames, and in response to a user selection allows

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to the user to view a recorded sequence of frames (see related citations regarding claim 1).

As to **claim 15**, Sisselman further teaches that the aforementioned method includes storing a first sequence and then looping back to the beginning of the first sequence and overwriting the first sequence with a second sequence of frames (see also discussion related to claim 2).

In regard to **claim 16**, the method involves an integral number of sequences of frames of predetermined duration.

As to **claims 17 and 18**, Sisselman further teaches that the method enabling a user to select to view either real time scene or recorded sequence of frames by choosing a playback mode (paragraph [0028]).

As to **claim 19**, Sisselman teaches a processor-based system for implementing a method of recording, overwriting and selectively viewing a recorded sequence of frames. While Sisselman does not explicitly teach that the processor includes a medium for storing instructions that enables it to execute the aforementioned method, it is notoriously known that the processor-based systems inherently have a medium for storing instruction that are being executed by the processor in order to make the processor-based system viable (see, for example a flow-chart in FIG. 8 reflecting a program executed by the processor).

As to **claim 20**, see discussion related to claims 2 and 15.

As to **claim 21**, see discussion related to claim 3 and 16.

As to **claims 22 and 23**, see rejection related to claims 13, 17 and 18.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sisselman in view of Hammack et al., ("Hammack"), US 6,088,053.

Sisselman discloses the device and corresponding method, wherein a sequence of frames of predetermined duration is recorded and consequently is overwritten by a following sequence of frames, and in response to a user selection allows to the user to view a recorded sequence of frames (see related citations regarding claim 1).

Sisselman does not teach that the replay device can be a binocular.

Hammack teaches a digital record and replay binocular having stereoscopic, telescopic and magnifying functions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement a recording and replaying method of Sisselman into the device of Hammack, because it would result in an improved apparatus, which would allow advantageously to view stereoscopic or 3D images as taught by Hammack (Hammack, column 1, line 53-61).

7. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sisselman in view of Ota, US 4,496,981.

Sisselman discloses the device and corresponding method, wherein a sequence of frames of predetermined duration is recorded and consequently is overwritten by a

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following sequence of frames, and in response to a user selection allows to the user to view a recorded sequence of frames.

Sisselman does not disclose, however, a particularity of optical arrangement in the device, wherein a beam splitter reflects light from a scene and from a monitoring display.

Ota teaches a video camera with a sensor and monitoring display (20 in FIG. 6), wherein a beam splitter (41) is used to reflect light from monitoring display and a scene into a viewfinder (10).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to implement an optical arrangement taught by Ota in the device of Sisselman, because it complements the teachings of Sisselman with the practical realization of method, wherein both viewing of a real scene and of the image produced by the monitoring display can be made available to the user.

8. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sisselman in view of Weyer, US 5,164,751 (reference of record provided with applicant's IDS).

Sisselman discloses the device and corresponding method, wherein a sequence of frames of predetermined duration is recorded and consequently is overwritten by a following sequence of frames, and in response to a user selection allows to the user to view a recorded sequence of frames

Sisselman does not teach that the device selectively enables a user to view the display or a scene through the optic element.

Weyer teaches a camera with instantaneous reviewing feature and enabling a user to observe the scene through a viewfinder (205) or to view a display (210)

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displaying recorded picture.

It would have been obvious to one of ordinary skill in the art at the time of the invention to give a user a choice of viewing the scene through the optics before taking a picture and then to view the picture taken on the display as taught by Weyer in the recording and viewing device of Sisselman, because it would allow the user to make an intelligent choice of a scene before taking a picture and thereafter to view the result of picture taken on the display for confirmation.

Allowable Subject Matter

9. **Claim 10** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and given that the claim 9, which claim 10 is dependent upon, is appropriately corrected.

10. The following is a statement of reasons for the indication of allowable subject matter: none of the references teach or fairly suggest a device as claimed in claim 1 and having a beam splitter arranged to reflect light from a display and direct it to a user; and reflect light from a scene and direct it to a sensor as would be required by corrected claim 9, wherein a viewing access to an optic element is controlled by a shutter.

Kawamura et al., US 5,153,569, discloses an optical apparatus having a display, beam splitter and a shutter for controlling the viewer's access to a scene and the display (see FIG. 11).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Ferrari, US 3,833,758, discloses video recording device with monitoring display.

Thornton, US 4,571,628, discloses a portable video viewing assembly employing a sensor, display and reflecting mirrors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is **(703) 306-2988**. The examiner can normally be reached on M-F (9:00 a.m - 4:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on **(703) 305-4709**.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone number is **(703) 306-0377**.

A handwritten signature in black ink, appearing to read 'Alexander Eisen', with a stylized flourish at the end.

Alexander Eisen
27 June 2003